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Jeffrey Y. Kao
Shell Oil Company
Legal-Intellectual Property
P.O. Box 2463
Houston TX 77252-2463

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OFFICE OF PETITIONS

In re Application of
Edwards, et al.
Application No. 10/678,889
Filed: October 3, 2003
Attorney Docket No. TH1647 03(US)
For: BRANCHED PRIMARY ALCOHOL
COMPOSITIONS AND DERIVATIVES
THEREOF

:
:DECISION ON PETITION
:UNDER 37 CFR 1.78(a)(3)
:
:

This is a decision on the petition under 37 CFR § 1.78(a)(3), filed October 18, 2004 (certificate of mailing date October 14, 2004), to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR § 1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed application.¹

The instant pending nonprovisional application was filed on October 3, 2003, and was pending at the time of filing of the instant petition. A reference to provisional application no. 60/257,670,

¹ Petitioner should submit another amendment eliminating the original first line of the specification, as (1) it is a claim for benefit to provisional application no. 60/257,670, filed December 21, 2000, (2) no intermediate application filed within 12 months of the provisional application is listed, and (3) the instant application was filed on October 3, 2003. The amendment filed with the present petition properly claims benefit to application nos. 10/025,080 and 60/257,670.

filed December 21, 2000, was included in the first line of the specification filed on October 3, 2003. While a reference to the prior-filed nonprovisional application, no. 10/025,080, filed December 19, 2001, was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR §§ 1.78(a)(3) or 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §§ 1.78(a)(2)(ii) or 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR §§ 1.78(a)(3) or 1.78(a)(6).²

In the instant case, the Office noted the claim for priority of the prior-filed nonprovisional application in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt, mailed January 5, 2004.

In view of the above, the \$1,370.00 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Petitions Attorney E. Shirene Willis at (571) 272-3230. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the Examiner of Technology Center AU 1751 for appropriate action on the amendment filed October 18, 2004 (certificate of mailing date October 14, 2004), including consideration of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) for benefit of the prior-filed application.



Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

² Note MPEP 201.11 (III)(D), pages 200-59 and 200-60 (Rev. 2. May 2004) and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.